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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/785,410

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Ryoichi Ueda

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT

PAPER NUMBER

2178

MAIL DATE

DELIVERY MODE

10/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,410

Applicant(s)

UEDA ET AL.

Examiner

MATTHEW J. LUDWIG

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12, 13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12, 13, and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment received 5/8/2008.
2. Claims 1-4, 6-10, 12, 13, 15, and 16 are pending in the application. Claims 1, 7, 13, and 16 are independent claims. Claims 17-21 are new claims.
3. Claims 1, 7, 13, 15, and 16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki.

Claim Objections

4. Independent claims 1, 7, and 13, are objected to because of the vexatious language found in the claims. More specifically, the examiner finds the expression 'therewith corresponding to' confusing and believes it should be changed so the claim reads more clearly. Also, the phrase 'replace therewith' is also similarly objected to. Finally, the phrase 'a document processing' seems to point to a process but it is not clear to the examiner. The Examiner suggests changing phrase to state 'produced through processing from another structured document'. The independent claims, as a whole, are difficult to interpret based upon the language found within each of the independent claims. Appropriate correction is suggested.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 16, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to independent claims 16, 17, and 18, the limitations include language which is contradictory in scope and cannot be regarded as cohesive steps as presently claimed. More specifically, the claims recite limitations that refer to 'alteration rules that sets a name of a second document structure definition to replace therewith and a name of a second document structure definition that is to be added, corresponding to the inconsistent element name'. The independent claims end with language stating 'dependent on whether the used second document structure definition is one to be added or one to replace therewith, respectively'. The last limitation seems to be directed to the previous step, however, the language is in the alternative and the prior limitation seems to be directed to both steps of 'replacing' and 'adding' occurring. The examiner is unsure as to what exactly is meant when the last limitation of the claims mentions 'depending on whether the used second document structure definition is one to be added or one to replace'.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1, 6, 7, 12, 13, 15, 16–18 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al., US Pat Pub. 2003/0093760 filed (11/12/2002).**

In reference to independent claim 1, Suzuki teaches:

'applying a document structure alteration rule, which is stored by storage means, to a first document structure definition written in a document structure definition language to express the structure of a structured document for the purpose of effecting conversion to generate a second document structure definition' (See Suzuki, page 3, 0044 through 0054). The reference discloses a conversion template contains description of an appropriate conversion rule based on interpreting a document type definition. In a document structure conversion process, the document structure of a structured document is converted according to the description of the conversion template in order to generate a new structured document (second structured document).

'wherein said document structure alteration rule includes a replacement rule for setting a document structure element name that is to be replaced in accordance with an element name contained in a document structure definition targeted for application and/or an addition rule for setting a document structure definition element name that is to be added corresponding to an element name contained in a document structure definition targeted for application' (See Suzuki, Figures 4a, 4b, and page 3, 0050 through 0055). Figures 4a and 4b show the template rules as an example of description of the conversion template of this embodiment. The example corrects the contradiction shown in figure 2 and the structured document is outputted by a single conversion. Also, the template describes an extraction rule regarding specific elements found in the document.

'conducting an inspection on an individual element name basis to determine whether said second document structure is consistent with a corresponding structured document' (See

Suzuki, page 7, 0103 through 0108). The reference discloses a shaping process based on the document structure and analyzes document structure prior to performing shaping.

In reference to dependent claim 6, Suzuki teaches:

Figure 1 illustrates an example flow of a conventional document conversion process for the structured document which is described by XML. See page 1, 0011 through 0014.

In reference to claims 7, 12, 13, 15, 16, 17, and 18, the claims recite similar limitations as those found in the method claims numbered 1 and 6. Therefore, the claims are rejected under similar rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 3, 4, 8, 9, and 1019, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., US Pat. Pub. 2003/0093760 filed (11/12/2002) in view of Dickinson et al., US 7,260,724 filed (9/20/2000).

In reference to dependent claim 2, Suzuki teaches:

‘wherein said replacement rule is applied to an element of said first document structure definition corresponding to an encrypted portion of said structured document for the purpose of effecting conversion to generate a corresponding document structure definition element’ (See Suzuki, page 3, 0044 through 0054). The reference discloses a conversion template contains

description of an appropriate conversion rule based on interpreting a document type definition. In a document structure conversion process, the document structure of a structured document is converted according to the description of the conversion template in order to generate a new structured document (second structured document). However, the reference fails to explicitly state the element corresponds to an encrypted portion of said structured document. Dickinson provides the transmission of encrypted portions of data through documents in a trusted network. It would have been obvious to one of ordinary skill in the art to have modified the document conversion methods as taught by Suzuki and included a specific type of document data such as encrypted data as it would have provided the elements taught by Suzuki with various types of data without varying from the reduction in time required for document conversion.

In reference to dependent claims 3 and 4, the limitations reflect similar language for performing specific types of document structure element conversion as claimed in dependent claim 2. Therefore, the claims are rejected under similar rationale.

In reference to claims 8, 9 and 10, 19, 20, and 21, the claims recite similar limitations to those found in the dependent claims numbered 1, 2, 3, and 4. Therefore, the claims are rejected under similar rationale.

Response to Arguments

11. Applicant's arguments with respect to claims 1-4, 6-10, 12, 13, 15, and 16 have been considered but are not persuasive.

Applicant states on page 13 that Suzuki fails to describe or suggest a document structure inspection method that includes the step of applying a document structure alteration rule to a first document structure definition written in a document structure definition language to express the

structure of a structured document for the purpose of effecting conversion to generate a second document structure definition. The Examiner disagrees and points to the template rules as an example of description of the conversion template and how the example corrects the contradiction shown in figure 2. Also, the template describes an extraction rule regarding specific elements found in the document. As presently claimed, the language states a replace/add feature that fails to accurately state a difference between the two steps. The vexatious language found within the independent claim fails to provide concise steps within the invention and leaves the claim open to multiple interpretations.

Furthermore, the applicant states on page 14, that Suzuki fails to describe or suggest a document structure inspection method comprising the step of conducting an inspection on an individual element name basis to determine whether a structured document which was produced through a document processing from another structured document is consistent by definition with said second document structure definition. However, as presently claimed, the language fails to preclude the examiner from utilizing the document conversion system that analyzes a first DTD and second DTD to extract the differences between the first DTD and the second DTD to provide a suggestion of applicant's claimed invention. The conversion template and the correction methods taught in the reference to Suzuki provide a generic but proficient example of the inspection methods as presently claimed.

On page 17 and 18, applicant states that Suzuki fails to describe or suggest a document structure inspection method that includes steps of suspending the first inspection and switching the first inspection to the second inspection using the second document structure definition. The ambiguous language found within the claim and rejected based upon U.S.C. 112 2nd paragraph

fails to accurately define the process of the 2nd inspection. The process of utilizing template files, correcting contradictions within the DTD's, and outputting a single conversion, suggests the method steps as presently claimed within independent claims 16, 17, and 18.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit
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